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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,934	08/07/2002	Axel Muntermann	(H)02MUN0018USP	9216

7590

05/05/2004

M Robert Kestenbaum  
11011 Bermuda Dunes NE  
Albuquerque, NM 87111

EXAMINER
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PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,934

Applicant(s)

MUNTERMANN, AXEL

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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This Office action replaces the previous Office action dated March 9, 2004. The March 9, 2004 Office action did not consider the preliminary amendment which had been previously filed but was not yet matched with the case. The following Office action is responsive to the March 9, 2004 preliminary amendment and to applicant's March 14, 2004 response to the first Office action.

***Specification***

The disclosure is objected to because of the following informalities: the specification makes reference to specific claims which is inappropriate. In particular, paragraph [004] of the substitute specification (which has been entered) still contains reference to the claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 26-29 claim both an apparatus and a method which overlaps two statutory classes of invention. See MPEP 2173.05(p)(II).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear as to the scope of the claim, specifically with its broad reference of a relative limitation with no particular indication as to what defines the limitation. That is, it is not clear what is an acceptable number of interference centers, and what constitutes a "reduced" number of interference centers.

Method claims 10-25 are all unclear in that none of the claims recite positive method steps. These claims should be rewritten in a format which includes active steps, such as "comprising the step of immersing the electrode in a solution..."

Claims 26-29 set forth two different statutory classes of invention (apparatus and method) and are therefore indefinite. See MPEP 2173.05(p)(II).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham et al ('671).

Cunningham et al discloses an electrode with a rounded tip. As asserted previously, it is impossible to determine what constitutes a "reduced number of electrical interference centers". The Cunningham et al electrode will inherently have a "reduced"

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number of such centers compared to at least other electrode known in the art. It is noted that the limitation of claims 3 and 4 are directed to a product by process, and weight is not given to the process of making the product (see MPEP 2113). Further, the Cunningham et al electrode is subjected to various electrolytes (e.g. saline and blood) and is made from platinum.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 and 15-26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al ('671) in view of the teaching of Eggers et al ('700).

Cunningham et al provide an electrode which presents a "reduced number of electrical interference centers" as set forth in claim 1. Further, Cunningham et al teach of providing the electrode in an electrolyte solution such as blood and/or saline fluid. However, Cunningham et al fail to specifically disclose a second electrode (e.g. return electrode) which is in contact with the solution.

Eggers et al disclose an analogous catheter device, and specifically teach that it is generally well-known in the art to provide such an electrosurgical ablation catheter with a return electrode on the catheter in proximity to the treatment electrode and in contact with a solution containing ions (i.e. saline or blood). An electric voltage is applied to the electrodes.

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While it is noted that applicant's intent is to claim a much different device/process than is taught by the prior art, the claims, as presently written, are sufficiently broad so as to be anticipated and obviated by the prior art as applied.

To have provided the Cunningham et al catheter as a bipolar catheter system having both active and return electrodes on the catheter body for the treatment of tissue would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Eggers et al.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 5-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/049,932. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specifically treated surface of the '932 application claims is a more specific embodiment of the

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instant application claims and deemed to be an obvious means for arriving at the reduced number of interference centers as set forth in the instant application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

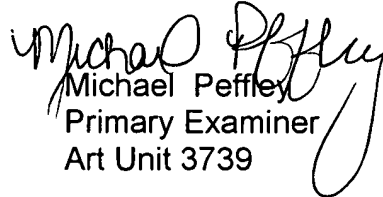
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Swanson et al, Jackman et al and Lontine et al all disclose various rounded, polished or coated electrodes. Applicant's specification alludes that these are all potential means for reducing electrical interference centers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

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April 21, 2004